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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/559,584

12/02/2005

Jonathan W. Roberts

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2701

23405

7590

04/25/2008

HESLIN ROTHENBERG FARLEY & MESITI PC  
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EXAMINER

STEELE, JENNIFER A

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

04/25/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/559,584	<b>Applicant(s)</b> ROBERTS ET AL.	
	<b>Examiner</b> JENNIFER STEELE	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) 14-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 19-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/02/2005</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Claim 14-18 withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Method of Making a Product, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 4/1/2008.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

2. **Claim 1-5, 7-13 and 19-21 rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts (US 4,704,322) in view of Scari et al (US 5,792,713).**

Roberts teaches a mica tape for use in wrapping electrically conductive substrates comprised of a scrims or sheet backing supports of glass cloth with a layer of mica

Art Unit: 1794

which may be in the form of mica paper, mica flakes, flake paper or splittings (col. 2, lines 26-45). Roberts teaches glass cloth that can be woven or braided cloth that are conventional and known. Roberts differs from the current application and does not teach that the glass filaments are a twist-free glass yarn.

Scari teaches a woven glass cloth for reinforcement for paper or resinous articles made of continuous glass filament warp yarns and weft yarns (ABST). Scari teaches a zero-twist yarn made of continuous glass filaments. Scari teaches the zero twist yarn provides advantages over prior art twisted filaments and allows for miniaturization, improved reinforcement of resinous impregnated glass reinforced articles (col. 7, lines 50-68).

It would have been obvious to one of ordinary skill in the art to substitute the zero-twist glass cloth for a convention glass woven cloth motivated to improve the properties of the glass reinforced mica tape.

As to claim 2, Roberts teaches a woven glass fabric.

As to claim 3, Roberts teaches a mica tape impregnated with a polymer resin.

As to claim 4 and 5, Roberts teaches a mica tape wherein the resin is a thermosetting epoxy resin (col. 3, lines 6-9).

As to claim 7-8 and 11-12, Roberts teaches the epoxy resin is present in the amount of about 20-50% by weight of the total composite (col. 2, lines 56-60). While Roberts does not teach an amount of 18%, Roberts teaches about 20% and 18% could be considered about 20% and it would have been obvious to try a lesser amount.

Roberts teaches that the amount of resin required can vary depending on the type of mica used and the final processing properties desires.

As to claim 9 and 10, Roberts teaches an accelerator of phenolic novolac accelerator of an alkoxy titanate (col. 3).

As to claim 13, Roberts teaches the product is in the form of a tape.

As to claims 19-21, Roberts teaches the materials, structure and process of making a mica tape that is same as the claimed invention and it is presumed that the mica tape has the property of insulating a wire up to a operation temperature of 450-1100°C. When the reference discloses all the limitations of a claim except a property or function, and the examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention the examiner has basis for shifting the burden of proof to applicant as in *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See MPEP § 2112- 2112.02

3. **Claim 6 rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts (US 4,704,322) in view of Scari et al (US 5,792,713) in further view of Andres et al (US 4,034,153).** Roberts in view of Scari differs from the current application and does not teach a silicone resin. Andres teaches a electrical cable with a mica insulating tape that is impregnated with a silicone resin as silicone remains flexible after curing (claim 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a silicone resin in the mica tape motivated to improve the properties of flexibility of the tape.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JENNIFER STEELE whose telephone number is (571)272-7115. The examiner can normally be reached on Office Hours Mon-Fri 8AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. S./  
Examiner, Art Unit 1794

/Elizabeth M. Cole/  
Primary Examiner, Art Unit 1794

4/22/2008